

**REMARKS**

Claims 1, 2, 6-7, 9, 12-16, 18, 19 and 34-39 were pending prior to the present amendments.

Claim 12 is amended to independent format and claims 2, 6 and 7 are amended to depend therefrom.

Claims 1, 13-16, 18 and 19 are canceled.

Claims 2, 6-7, 9 and 12 are now pending.

Claims 34-39 are withdrawn and are anticipated to be reinstated for the reasons set forth herein.

Reconsideration on the merits is respectfully requested.

No new matter is entered by the amendments.

The claims are believed to be allowable for the reasons set forth herein. Notice thereof is respectfully requested.

**Election/Restrictions**

Claims 34-39 are withdrawn from consideration as being directed to a non-elected invention. Applicants respectfully disagree.

Claims 34-39 are method claims of substantially similar scope to system claims 13-16 and 18-19, respectively. Claims 34-39 were recommended by the Examiner in a telephone interview

of March 3, 2004 wherein claim 13 was suggested, by the Examiner, to be better presented as a method claim. A parallel review of claim 34 with claim 13 will indicate that the scope is substantially similar.

The Office opines the "Applicant elected to prosecute a method for electronic commerce over a computer network and a system for performing the method". Claims 34 and 13 are related as method and system which is within the invention elected by Applicant. Applicant respectfully request that the claims recommended by the Office, and within the scope of the elected invention, receive a first review on the merits.

#### Drawings

The drawings are objected to under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims.

The Office opines that the computer network in Figure 2 must be shown or the feature(s) canceled from the claims. The Office has failed to indicate which features may be missing leaving Applicant to guess at the meaning of the vague objection. Nevertheless, Applicants submit that each element of

claim 1 is covered in the Figures. Figure 2 is a flow diagram illustrating the flow of information over a computer network. Figure 2 is not intended to be a structural representation of a computer system and therefore structural elements are not necessary. Each arrow indicates a transmittal of information which is an action. The action occurs over a network of computers as clearly set forth in the specification.

The Office further opines that Figure 5 contains three networks whereas claim 1 requires one network. The attention of the Office is drawn to the preamble wherein the term "comprises" is used to indicate that the claim is not limited to just those structural elements recited. Even then the position by the Office is in error. Paragraph [0064] of the specification states:

It is preferred that the networks, 54, 66 and 90 are one network and more preferably the network is the world wide web".

The position of the Office that Figure 5 contains three networks while claim 1 requires one network is in error for several reasons. First, claim 1 allows for at least one network owing to the use of the open term "comprises". Second, Figure 5 illustrates three separate elements, 54, 66 and 90, but the text

clearly indicates that these may be taken together in a single element.

Applicants respectfully submit that the objection to the drawings is in error and should be withdrawn. Drawing corrections are not required and the comments herein are fully responsive and overcome the objection.

#### Claim Objections

Claims 1, 12, 15, 18 and 19 are objected to because of informalities.

Claims 1, 15, 18 and 19 are canceled and all objections directed thereto are moot.

In claim 1 a semicolon is requested after "network" in line 23. A semicolon would be improper since this is a continuing phrase just as in the preceding three "transmitting" clauses and the two that follow (excluding the phrase where "network" is the terminal term in the clause). The objection was improper with regards to claim 1 and now amended claim 12.

Claim 12 is objected to for depending from canceled claim 11. Claim 12 has been amended to independent form thereby rendering the rejection moot.

Specification

The disclosure is objected to because of informalities regarding the descriptions corresponding to certain arrows and apparent inconsistencies. The specification has been amended to move the designator thereby clearly indicating that the action is indicated by the arrow. The objection is therefore overcome by amendment.

Claim Rejections - 35 USC § 101

Claims 1, 2, 6, 7, 9, 13-16, 18 and 19 are rejected under 35 U.S.C. § 101 based on the argument that the claimed invention lacks patentable utility.

Claims 1, 13-16, 18 and 19 are canceled thereby rendering the rejection moot. Claims 2, 6, 7 and 9 now depend from claim 12 which is considered allowable over 35 U.S.C. § 101. Claims 2, 6, 7 and 9 are patentable for, at least the same reasons as claim 12.

The Office has taken the liberty to devise a claim and then proceed to reject the devised claim. The devised claim is a

simplified claim by admission of the Office. Applicants are at a loss as to how to provide a suitable response to a rejection against a claim which has been submitted by the Office. The Office has developed an example, based on the devised claim, whereby certain funds are transferred from the customer to the dealer to the manufacturer. In this hypothetical example the Office then ask the Applicant to answer whether or not the hypothetical scenario is correct. In the hypothetical example the Office has ignored, among other things, the dealer price adjustment which the customer may have no visibility of.

Applicants respectfully request that the claim submitted by the Applicant be examined not the claims submitted by the Office.

The rejection is apparently directed to hypothetical claim 1 prepared by the Office and is therefore improper.

#### Claim Rejections - 35 USC § 112

Claims 1, 2, 6, 7, 9 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims are argued to contain subject matter

which was not described in the specification in such a way as to enable one of skill in the art to which it pertains.

Claim 1 is canceled in favor of independent claim 12.

The Office argues that it would be unclear how one of skill in the art would derive the availability index from the dealer price adjustment. The Office then asks if there is a formula for deriving the availability index. Attention is drawn to paragraph [0033] of the specification, as filed, wherein stated is:

"The DAR,<sup>4</sup>, comprises a dealer availability index (DAI) which may comprise an affirmation, a percentage available or a date available."

The dealer availability index is a response to indicate availability of a requested item by a specific dealer. This is not a number derived from other input but instead is a raw input from the dealer. One of skill in the art would certainly be able to combine multiple input items from one location and transmit them to another location as a single response.

Applicants respectfully submit that the format of this data is not limiting herein and one of skill in the art could devise any number of formats to transmit a response to a query, or multiple queries, from one computer to another.

Applicants have used the word derive, and its derivatives, in accordance with the normal use in the language (as set forth in New Webster's Dictionary of the English Language, College Edition, copyright 1975 by Consolidated Book Publishers, ISBN 0 8326-0035-0) to mean "to draw or obtain from a source of origin". In the present invention the source of origin of the dealer availability index is the dealer.

The rejection of remaining claims 2, 6, 7, 9 and 12 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is improper. Each and every term is defined in the specification therefore the requirement is met. Withdrawal of the rejection is respectfully requested.

Claims 1, 2, 6, 7, 9 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 1, 2, 6, 7, 9 and 12 are also rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

Claim 1 is canceled in favor of now independent claim 12.

Each step of the inventive process comprises a transmission of information. The receiver of the information takes some part

of that transmission, adds to it typically in the form of a response to a query and forwards it. Each subsequent transmission therefore derives from the previous transmission since it is related as a query and response. The Office appears to be confusing "derived" with some form of mathematical calculation. There is no mathematical formula there is a series of information transmissions based on the previous transmission and possibly including a portion of the previous transmission. For example, the product identifier would likely transmit through the entire sequence of transmissions in most embodiments. The product identifier would therefore derive from the initial customer transmission. One of skill in the art would clearly realize and understand this transfer of information and be able to devise a protocol and format for such based on the descriptions herein.

Claim 12 does not contain the statement that the product is transferred through the computer network.

Claims 2, 6, 7, 9 and 12 clearly comply with the written requirement and one of ordinary skill in the art would be able to read the specification and develop a system to duplicate the method without undue experimentation. The claims are therefore

adequately supported and enabled and the rejections under 35 U.S.C. 112, first paragraph, are improper and removal is respectfully requested.

Claims 13-16, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-16, 18 and 19 have been canceled thereby rendering the rejection moot.

Claim Rejections - 35 USC § 103

Claims 1, 2, 6-7, 9, 13-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp et al. (U.S.P 6,263,317).

Claims 1, 13-16, 18 and 19 have been canceled and all rejections directed thereto are moot. Claims 2, 6-7 and 9 have been amended to depend from claim 12. Claim 12 is patentable over Sharp et al. The rejection of claims 2, 6-7 and 9 under 35 U.S.C. § 103 is rendered moot by amendment.

## **CONCLUSIONS**

Claims 2, 6, 7, 9, 12-16, 18, 19 and 33-39 are pending in the present application.

Claims 33-39 were improperly withdrawn and an allowance or first action on the merits is now proper.

All claims are believed to be in condition for allowance. Notice thereof is respectfully requested.

Respectfully submitted,

  
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